



3676

HDP/SB/21 based on PTO/SB/21 (08-00)

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/998,483
Filing Date	November 30, 2000
First Named Inventor	Oprea Duta et al.
Group Art Unit	3676
Examiner Name	Alison K. Pickard
Attorney Docket Number	3196-000161

Total Number of Pages in This Submission	5
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Remarks

The Commissioner is hereby authorized to charge any additional fees that may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 08-0750. A duplicate copy of this sheet is enclosed.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Harness, Dickey & Pierce, P.L.C.	Attorney Name	Michael E. Hilton	Reg. No.	33,509
Signature					
Date	22 - OCT - 2003				

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/998,483  
Filing Date: November 30, 2001  
Applicant: Oprea Duta et al.  
Group Art Unit: 3676  
Examiner: Alison K. Pickard  
Title: OIL SEAL JOURNAL TEXTURING AND METHOD THEREOF  
Attorney Docket: 3196-000161

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**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action mailed September 24, 2003, please consider the following:

The Examiner has required restriction under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 2-8, drawn to a method of texturing a shaft, classified in class 72, subclass 53;
- II. Claims 1 and 9-16, drawn to (at least) a shaft with seal area, classified in class 277, subclass 559.

The Examiner concludes that the inventions are distinct since the product

as claimed can be made by another and materially different process. In support of this assertion, the Examiner states: "[i]n the instant case the bumps on the shaft surface can be made by means other than shot peening, such as by molding."

Although the Examiner's statement is correct, the claims of Group I (e.g. Claim 2) do not require a process that relies on shot peening. In fact, the claims of Group II would read upon molding bumps on the shaft surface. Thus, the basis provided by the Examiner for the distinctiveness of these inventions is wholly without merit.

Applicants further respectfully submit that the claims of the two designated groups have not acquired a separate status in the art, notwithstanding possible different classifications which may be artificially assigned. Art very relevant to the patentability of the Group I claims might very logically be found in the art class assigned by the Examiner to Group II. Likewise, art very relevant to the patentability of the Group II claims might easily be found in the classification assigned by the Examiner to the Group I claims. Furthermore, art relating to the patentability of both groups of claims might easily be found within a number of additional art classifications.

In short, the classifications cited to support restriction are merely for cataloging purposes and are not conclusive of the propriety of restriction. It is submitted that the claims of the two groups designated by the Examiner are closely inter-related and in order to preserve unity of invention, both groups should be prosecuted in the same application. An important advantage in pursuing just one application is that the examination work of the Patent Office would thereby be simplified in as much as duplication of searching effort would be eliminated. Thus, restricting the application as

suggested by the Examiner would increase searching effort rather than reduce it. Accordingly, search and examination can be made without serious burden, and, therefore, the Examiner must examine this application on the merits, even if the claims are independent and distinct (MPEP 803).

In view of the foregoing remarks, it is respectfully requested that the Examiner withdraw his requirement for restriction and allow the claims of Group I (Claims 2-8) to be prosecuted in the same application as the claims of Group II (Claims 1 and 9-16). In the event that the Examiner's restriction requirement is made final, Applicants provisionally elect the claims of Group II (Claims 1 and 9-16) for continued prosecution, holding the claims of Group I (Claims 2-8) in abeyance under the provisions of 37 CFR 1.142(b) until final disposition of the elected claims.

#### CONCLUSION

It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this Response is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 22 - OCT - 2003

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